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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,835	02/14/2001	Shozo Nagano	30-5000-(4015) -Div3	2586

7590 12/05/2002

David G Latwesen PH.D  
Wells St John  
601 West First Avenue  
Suite 1300  
Spokane, WA 99201

EXAMINER

IP, SIKYIN

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 12/05/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 5/14/01; 8/20/02; 9/26/02
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 53-55, 60-69 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 53-55, 60-69 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 131, 15
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:  
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
2. Claim 64 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification as originally filed discloses “uniformly distributed fine precipitates” (page 11, lines 11-19, for example) but fails to define what are the standards or measurements of the “uniformly” and “fine”.
3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 64 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 64 is indefinite because of the wording “as”. It is unclear whether the limitation(s) following the phrase are part of the claimed invention or not, and the resulting claim does not clearly set forth the metes and bounds of the patent

protection desired. Ex parte Koch, 66 USPQ 490 and Ex parte Steigerwald, 131 USPQ 74.

***Claim Rejections - 35 USC § 103***

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 53-55, 60, 62, and 64-69 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 5590389 to Dunlop et al.

9. The Dunlop disclose(s) the features including the claimed Cu based target

material and grain size (col. 3, line 65 to col. 4, line 9 and lines 22-25; and col. 5, line 66 to col. 6, line 2), and second phase/precipitate (col. 2, lines 18-26). The difference between the reference(s) and the claims are as follows: Dunlop does not disclose purity of the Cu element, electromigration resistance, and thermal stability as recited in instant claims 66-68. However, using high purity elemental Cu for sputtering target material is known in art of cited reference. The instant Cu based sputtering target material is overlapped by the cited reference; consequently, the electromigration resistance and thermal stability properties as recited in the instant claims would have been inherently possessed by the teachings of the cited reference. Therefore, the burden is on the applicant to prove that the product of the prior art does not necessarily or inherently possess characteristics attributed to the claimed product.

In re Best, 195 USPQ, 430 and MPEP 2112.01.

“Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, *In re Best*, 195 USPQ 430, 433 (CCPA 1977). ‘When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.’ *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 195 USPQ 430, 433 (CCPA 1977).”

10. Claims 61 and 63 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 5590389 to Dunlop et al in view of USP 4786469 to Weber et al and JP 49007777.

11. The Dunlop reference(s) disclose(s) the features including the claimed sputtering target with ultra-fine grains. The features relied upon described above can be found in the Dunlop reference(s) at col. 1, lines 21-25 and lines 45-59; and col. 4, lines 10-27. The difference between the reference(s) and the claims are as follows: Dunlop does not explicitly disclose the claimed Cu based alloy containing Tc and Tl elements. However, Weber in the abstract and col. 3, lines 21-34 disclose(s) alloying elements that would refine Cu alloy grain size in the same field of endeavor or the analogous metallurgical art. JP 49007777 in the abstract discloses Tl element is known to improve Cu alloy heat resistance and electrical conductivity. Therefore, combining known ingredient having known functions, to provide a composition having the additive effect of each of the known functions is within realm of performance of ordinary skill artisan. It has been held that combining known ingredient having known functions, to provide a composition having the additive effect of each of the known functions is within realm of performance of ordinary skill artisan. In re Castner, 186 USPQ 213 (217) and In re Raner, 134 USPQ 343 (CCPA 1962).

*Response to Arguments*

12. Applicant's arguments filed September 26, 2002 have been fully considered but they are not persuasive.

13. Applicants argue that grain refining elements of Weber require Ti and/or Zr. But, instant claim 53 has open transitional expression "comprising" which is inclusive and fails to exclude unrecited ingredients even in major amounts. See *Ex parte Davis et al.* (POBA 1948) 80 USPQ 448 and *In re Bertsch* 132 F2d 1014, 56 USPQ 379 (CCPA 1942).

14. Applicants argue that Weber does not teach Cu based sputtering target. But, Weber teaches to refine Cu based alloys grains (see abstract) which would benefit the ultrafine grain sputtering target materials of Dunlop (col. 1, lines 45-59). It has been held that combining known ingredient having known functions, to provide a composition having the additive effect of each of the known functions is within realm of performance of ordinary skill artisan. *In re Castner*, 186 USPQ 213 (217) and *In re Raner*, 134 USPQ 343 (CCPA 1962).

15. Applicants' argument with respect to Sakamoto is noted. But, applicants appeared agree the claimed copper based alloy composition is overlapped by the copper based alloy composition of Sakamoto.

16. Applicants argue that Sakamoto does not disclose the claimed intended sputtering target use. It has been held that a prior art reference must either be in the

field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Cu based alloy as taught by Sakamoto has very good heat resistance and electrical conductivity for sputtering application.

### ***Conclusion***

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Examiner Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (703)-308-1146.


The facsimile phone number for this Art Unit 1742 are (703) 305-3601 (Official Paper only) and (703) 305-7719 (Unofficial Paper only). When filing a FAX in Technology Center 1700, please indicate in the Header (upper right)



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"Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

  
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SIKYIN IP  
PRIMARY EXAMINER  
ART UNIT 1742

S. Ip  
December 1, 2002